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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,285	12/26/2000	Gene R. Anderson	1613370-0012	5735

7470 7590 05/28/2004  
WHITE & CASE LLP  
PATENT DEPARTMENT  
1155 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036

EXAMINER	
LE, THANH TAM T	
ART UNIT	PAPER NUMBER
2839	

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/749,285

Applicant(s)

ANDERSON ET AL.

Examiner

Thanh-Tam T. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 46-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/18/04; 3/8/04; 12/29/03;
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

11/14/03; 10/27/03;  
8/14/03

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-45, drawn to an apparatus for connecting a first optical connector to a second optical connector, classified in class 385, subclass 53.
  - II. Claims 46-51, drawn to an apparatus for housing a flexible printed circuit board, classified in class 385, subclass 94.
2. Inventions Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are for connecting a first optical connector to a second optical connector and for housing a flexible printed circuit board.
3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with James M. Wu on 5/24/04 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-45. Affirmation of this election must be made by applicant in replying to this Office action. Claims 46-51 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 16-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16, "an elastomeric member proximate to the first end of the housing and capable of generating an outward elastomeric force" is confusing.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-6 and 31-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Vergeest (6,585,423).

Regarding claims 1 and 31, Vergeest, figure 9a, discloses an apparatus for connecting a first optical connector (1) to a second optical connector (2), comprising:

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- a housing (4) having at least a first end capable of receiving the first optical connector and a second end capable of receiving the second optical connector;
- a longitudinal cavity extending from the first to the second end of the housing; and
- an electromagnetic shield involving in at least a portion of the housing.

Regarding claim 2, the electromagnetic shield comprising a metallic coating on the at least the portion of the housing.

Regarding claims 3 and 33, figure 8c, the longitudinal cavity is capable of facilitating the alignment of the first optical connector and the second optical connector.

Regarding claims 4 and 34, figure 8c, alignment guides (41 and 42) inside the longitudinal cavity of the housing. The alignment guide capable of aligning the first optical connector to the second optical connector.

Regarding claims 5 and 35, figure 8c, alignment wings (41) adapted to the second end of the housing. The wings capable of holding the second optical connector.

Regarding claims 6 and 36, a cavity at the first end of the housing. The cavity functioning to house at least optoelectronic circuitry used in connection with the first optical connector.

Regarding claim 32, the alignment members function to hold a align the position of the first optical connector relative to the position of the housing.

9. Claims 1 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Ngo (6,572,272).

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Ngo, figure 1, discloses an apparatus for connecting a first optical connector (B) to a second optical connector (A), comprising:

- a housing (10) having at least a first end capable of receiving the first optical connector and a second end capable of receiving the second optical connector;
- a longitudinal cavity extending from the first to the second end of the housing; and
- an electromagnetic shield involving in at least a portion of the housing.

10. Claims 1, 8, 13-15, 31, 38 and 43-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson et al. (5,923,805).

Regarding claims 1 and 31, Anderson et al., figure 3, discloses an apparatus for connecting a first optical connector (51) to a second optical connector (50), comprising:

- a housing (32) having at least a first end capable of receiving the first optical connector and a second end capable of receiving the second optical connector;
- a longitudinal cavity extending from the first to the second end of the housing; and
- an electromagnetic shield involving in at least a portion of the housing.

Regarding claims 8 and 38, tabs (311 and 312) adapted to the first end of the housing. The tabs capable of mating with slots on a mounting structure (800).

Regarding claims 13-15 and 43-45, the first and second optical connectors are MT-type connectors, ferrules and MT-type ferrules.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 7 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vergeest (6,585,423) in view of Knapp et al. (5,768,456).

Vergeest disclose the instant claimed invention as described above except for the cavity houses at least a portion of a flexible printed circuit board that is adapted to a mounting structure.

Knapp et al., figure 1, disclose a flexible printed circuit board (18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Vergeest to have the flexible printed circuit board as taught by Knapp et al. for better connection.

13. Claims 9-12 and 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ngo (6,572,272).

Regarding claims 9-11 and 39-41, Ngo discloses alignment pin/screw (46) capable of mating with pin-positioning hole on a mounting structure (82), except a plurality of pins/screws. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ngo to have a plurality of pins/screws, since it has been held that mere duplication of the essential working parts of a device involves

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only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, in order to have more security.

Regarding claims 10-12 and 40-42, disclose the instant claimed invention as described above except for pin-positioning holes adapted to the first end of the housing and alignment pins on the mounting structure.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ngo to have pin-positioning holes adapted to the first end of the housing and alignment pins on the mounting structure, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167, in order to an alternative way to mount the housing into the mounting structure.

### ***Response to Arguments***

14. Applicant's arguments with respect to claims 1-51 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh-Tam T. Le whose telephone number is 571-272-2094. The examiner can normally be reached on 7:30-5:00.



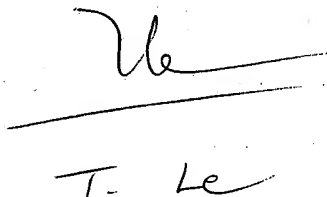
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16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild can be reached on 571-272-2092. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TL

5/25/05

  
T. Le